

1 Kalpana Srinivasan
California State Bar No. 237460
2 ksrinivasan@susmangodfrey.com
SUSMAN GODFREY LLP
3 1900 Avenue of the Stars, Suite 1400
Los Angeles, CA 90067
4 Telephone: (310) 789-3100
5 Facsimile: (310) 789-3150

6 Ravi Bhalla
Pro hac vice forthcoming
7 New York State Bar No. 5478223
rbhalla@susmangodfrey.com
8 **SUSMAN GODFREY LLP**
9 1301 Avenue of the Americas, 32nd Fl.
New York, NY 10019
10 Telephone: (212) 336-8330
11 Facsimile: (212) 336-8340

12 *Attorneys for Plaintiff California Institute of
Technology*

13 **UNITED STATES DISTRICT COURT**
14 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
15 **SAN JOSE DIVISION**

16 CALIFORNIA INSTITUTE OF
TECHNOLOGY,

17 Plaintiff,

18 v.

19 SAMSUNG ELECTRONICS CO., LTD. and
20 SAMSUNG ELECTRONICS AMERICA,
21 INC.

22 Defendants.
23
24
25
26
27

Case No. 5:22-MC-80318

E.D. Tex. Case No. 2:21-CV-0446-JRG

**PLAINTIFF CALIFORNIA INSTITUTE
OF TECHNOLOGY'S NOTICE AND
MOTION TO COMPEL SUBPOENA
COMPLIANCE BY BROADCOM CORP.
AND BROADCOM INC. AND
MEMORANDUM IN SUPPORT**

Date: December 27, 2022

Time: 10:00 AM PT

TABLE OF CONTENTS

NOTICE OF MOTION1

ISSUES TO BE DECIDED1

MEMORANDUM OF POINTS AND AUTHORITIES.....1

 I. Introduction.....1

 II. Background3

 A. The Asserted Patents.....3

 B. The C.D. Cal. Action against Broadcom and Apple.....4

 C. The E.D. Tex. Action against Samsung.....5

 D. The Broadcom Subpoenas6

 III. Legal Standard8

 IV. Argument8

 A. The discovery sought from Broadcom is relevant.8

 B. The discovery sought from Broadcom is proportional.9

 C. Broadcom is not entitled to assert a claim preclusion defense.11

 D. There is no claim preclusion.12

 E. There is no claim splitting.....19

 V. Conclusion20

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Adams v. California Dep’t of Health Servs.</i> , 487 F.3d 684 (9th Cir. 2007)	19
<i>Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.</i> , 672 F.3d 1335 (Fed. Cir. 2012).....	14
<i>Bell v. United States</i> , No. CV F 02–5077, 2002 WL 1987395 (E.D. Cal. 2002)	11
<i>Brain Life, LLC v. Elekta Inc.</i> , 746 F.3d 1045 (Fed. Cir. 2014).....	12, 13
<i>California Inst. of Tech. v. Broadcom Ltd.</i> , 25 F.4th 976 (Fed. Cir. 2022)	4
<i>Foster v. Hallco Mfg. Co.</i> , 947 F.2d 469 (Fed. Cir. 1991).....	13
<i>Fresenius USA, Inc. v. Baxter Int’l, Inc.</i> , 721 F.3d 1330 (Fed. Cir. 2013).....	17
<i>Gonzales v. Google, Inc.</i> , 234 F.R.D. 674 (N.D. Cal. 2006).....	8
<i>Hartsel Springs Ranch of Colorado, Inc. v. Bluegreen Corp.</i> , 296 F.3d 982 (10th Cir. 2002)	19
<i>Hurd v. D.C.</i> , 864 F.3d 671 (D.C. Cir. 2017).....	12
<i>Khalilpour v. CELLCO P’ship</i> , No. C 09-02712 CW MEJ, 2010 WL 1267749 (N.D. Cal. Apr. 1, 2010)	8
<i>Mendenhall v. Barber-Greene Co.</i> , 26 F.3d 1573 (Fed. Cir. 1994).....	17
<i>MLC Intell. Prop., LLC v. Micron Tech., Inc.</i> , No. 19-CV-03345, 2019 WL 4963253 (N.D. Cal. Oct. 8, 2019)	15
<i>Mpoyo v. Litton Electro–Optical Sys.</i> , 430 F.3d 985 (9th Cir. 2005)	12, 13

1	<i>Oyster Optics, LLC v. Cisco Sys., Inc.</i> ,	
2	No. 2:20-CV-00211-JRG, 2021 WL 1530935 (E.D. Tex. Apr. 16, 2021)	12, 15, 16, 17
3	<i>Republic of Ecuador v. Mackay</i> ,	
4	742 F.3d 860 (9th Cir. 2014)	8
5	<i>Rivet v. Regions Bank of Louisiana</i> ,	
6	522 U.S. 470 (1998)	12
7	<i>Rogers v. Rivera</i> ,	
8	No. 115CV00007MCASCY, 2017 WL 3405606 (D.N.M. Mar. 28, 2017)	11
9	<i>In re Samsung Elecs. Co.</i> ,	
10	No. 22-MC-80005-VKD, 2022 WL 425579 (N.D. Cal. Feb. 11, 2022)	8
11	<i>SanDisk Corp. v. Kingston Tech. Co.</i> ,	
12	695 F.3d 1348 (Fed. Cir. 2012)	15
13	<i>SanDisk Corp. v. Round Rock Rsch. LLC</i> ,	
14	No. 11-CV-05243-RS, 2014 WL 691565 (N.D. Cal. Feb. 21, 2014)	8
15	<i>In re Schimmels</i> ,	
16	127 F.3d 875 (9th Cir. 1997)	18
17	<i>Semtek Int’l Inc. v. Lockheed Martin Corp.</i> ,	
18	531 U.S. 497 (2001)	16
19	<i>SimpleAir, Inc. v. Google LLC</i> ,	
20	884 F.3d 1160 (Fed. Cir. 2018)	16
21	<i>Tahoe-Sierra Pres. Council, Inc. v. Tahoe Reg’l Plan. Agency</i> ,	
22	322 F.3d 1064 (9th Cir. 2003)	18
23	<i>Taylor v. Sturgell</i> ,	
24	553 U.S. 880 (2008)	11
25	<i>XY, LLC v. Trans Ova Genetics, LC</i> ,	
26	968 F.3d 1323 (Fed. Cir. 2020)	13

NOTICE OF MOTION

Plaintiff California Institute of Technology (“Caltech”) respectfully moves this Court for entry of an order under Rules 37 and 45 of the Federal Rules of Civil Procedure compelling Broadcom Corp. and Broadcom Inc. (together, “Broadcom”) to produce documents in accordance with subpoenas served on both entities in a case pending in the United States District Court for the Eastern District of Texas, *California Institute of Technology v. Samsung Electronics Co., Ltd. et al.*, No. No. 2:21-CV-0446-JRG (the “E.D. Tex. Action”). In accordance with N.D. Cal. Civil Local Rule 7-2(a), Caltech notices this motion for December 27, 2022 at 10:00 AM PT. The grounds for this Motion are set forth in the Memorandum of Points and Authorities below and the accompanying Declaration of Ravi Bhalla (“Bhalla Dec.”).

ISSUES TO BE DECIDED

Whether non-parties Broadcom Corp. and Broadcom Inc. should be compelled to produce documents and source code in response to subpoenas seeking relevant information relating to Wi-Fi chips that they supply to Samsung.

MEMORANDUM OF POINTS AND AUTHORITIES

I. Introduction

Non-party Broadcom is resisting straightforwardly relevant discovery regarding Wi-Fi chips that it sold to Samsung with a claim preclusion argument that is not an appropriate basis to resist discovery, that Broadcom is not entitled to assert as a third party, and that is, in any event, a meritless defense. And Broadcom raises no argument as to burden—nor could it do so given the clear nature of Caltech’s requests and that Broadcom has gathered similar discovery for another action. This Court should roundly reject Broadcom’s attempts to skirt its discovery obligations on the basis of its novel and inapplicable claim preclusion argument and order full compliance with the subpoenas Caltech served.

In connection with patent litigation that Caltech has against Samsung, Caltech seeks from Broadcom documents and source code relating to Wi-Fi chips that Broadcom supplies to Samsung.

1 Because Samsung identified these Broadcom chips as performing a relevant functionality in the
2 accused infringing products, the discovery Caltech seeks from Broadcom about the operation of
3 the chips is relevant to its case against Samsung.

4 The discovery is also proportional, not only because it is tailored to the precise set of 20
5 Broadcom chips that Samsung has identified, but also because Broadcom has already collected
6 and produced much of the requested material for 18 of the chips in ongoing litigation that Caltech
7 has against Broadcom in the Central District of California. *See California Institute of Technology*
8 *v. Broadcom Ltd., et al.*, No. 2:16-cv-03714 (C.D. Cal.) (the “C.D. Cal. Action”). The burden on
9 Broadcom is thus minimal, and because the protective order in the C.D. Cal. Action prevents
10 Caltech from using the discovery it received from Broadcom outside of that litigation, Broadcom
11 is the appropriate party to provide the information at issue.

12 Nonetheless, Broadcom will not comply with the subpoenas, straining to justify its refusal
13 with a claim preclusion argument that is not a basis for a third party to refuse to produce responsive
14 discovery to a subpoena, and, in any event, is also meritless. According to Broadcom, it need not
15 comply with the subpoenas because the C.D. Cal. Action involves some of the same chips that are
16 also used in Samsung products at issue in the E.D. Tex. Action and Caltech is therefore precluded
17 from obtaining information about those chips in the E.D. Tex. Action.

18 Broadcom is not a defendant in Caltech’s case against Samsung. It thus has no standing or
19 basis to assert a claim preclusion defense in the E.D. Tex. Action because there are no claims
20 against Broadcom in that case. Samsung, the actual defendant in the case, has not resisted
21 providing discovery into its products that use Broadcom chips. Indeed, the whole reason Caltech
22 subpoenaed Broadcom in the first place is because Samsung identified certain Broadcom chips as
23 relevant to Samsung’s accused products.

24 Moreover, claim preclusion does not apply at all. First, the E.D. Tex. Action and the C.D.
25 Cal. Action do not involve the same claims or causes of action. Across the two suits, not only are
26 different products at issue, but there is also an additional patent and additional patent claims at
27

1 issue in the E.D. Tex. Action that are not at issue in the C.D. Cal. Action. Caltech also expressly
 2 carved out damages based on Samsung products that use Broadcom chips from the relief it is
 3 seeking in the C.D. Cal. Action, further separating the claims at issue across the two Actions.
 4 Broadcom has explicitly acknowledged this in its correspondence with Caltech. *See* Ex. 5 at 4
 5 (Broadcom acknowledging “Caltech’s decision in the prior case to drop its claims against Samsung
 6 products containing Broadcom chips”). Second, there is no final judgment in the C.D. Cal. Action
 7 that can form the basis of any claim preclusion in the E.D. Tex. Action. And third, Broadcom and
 8 Samsung, two entities with an arms-length commercial relationship, are not in privity. No matter
 9 which way it’s sliced, claim preclusion simply does not apply.

10 For all these reasons, and those that follow, this Court should order Broadcom’s
 11 compliance with the subpoenas at issue.

12 **II. Background**

13 **A. The Asserted Patents**

14 The patents at issue are U.S. Patent Nos. 7,116,710 (the “710 patent”), U.S. Patent No.
 15 7,421,032 (the “032 patent”), U.S. Patent No. 7,916,781 (the “781 patent”), and U.S. Patent No.
 16 8,284,833 (the “833 patent”) (together, “the Asserted Patents”). The Asserted Patents disclose a
 17 class of error correction codes, and the claimed methods and apparatuses in the Asserted Patents
 18 are directed to encoders and decoders. The technology disclosed in the Asserted Patents can be
 19 used to correct errors in transmissions that occur over a wireless communications channel, such as
 20 Wi-Fi. E.D. Tex. Dkt. 75 ¶¶ 27, 32-33 (Second Amended Complaint).

21 Wi-Fi is used in a wide array of modern consumer electronics, such as smartphones,
 22 televisions, and computers, and the functionality typically involves the use of a Wi-Fi chip
 23 installed in the consumer electronic device. The Institute of Electrical and Electronics Engineers
 24 (“IEEE”) develops and maintains standards for Wi-Fi. Three of the more recent versions of the
 25 IEEE Wi-Fi standard—IEEE 802.11n, 802.11ac, and 802.11ax—involve the use of specific low-
 26 density parity check (“LDPC”) error correction codes to improve performance and reduce errors
 27

1 in transmission. *Id.* ¶¶ 31-33. These LDPC codes can be implemented by using the
 2 encoder/decoder technology disclosed by the Asserted Patents. *Id.* ¶ 33.

3 **B. The C.D. Cal. Action against Broadcom and Apple**

4 The C.D. Cal. Action was filed in 2016. Caltech initially asserted all four of the Asserted
 5 Patents against Apple Inc. and Broadcom, but two years before trial, Caltech voluntarily withdrew
 6 the ‘833 patent, without prejudice. C.D. Cal. Dkt. 397 (Caltech’s “Notice of Withdrawal of Certain
 7 Asserted Claims of Asserted Patents”). Caltech also voluntarily withdrew all but the following
 8 claims of the ‘781, ‘710, and ‘032 Patents prior to trial: claims 11 and 18 of the ‘032 Patent, claims
 9 13 and 22 of the ‘781 Patent, and claims 20 and 22 of the ‘710 Patent. C.D. Cal. Dkt. 1451
 10 (Caltech’s notice “withdrawing its infringement allegations with respect to all remaining claims”
 11 except for those listed).

12 In 2020, a jury found that Wi-Fi products from Apple and Broadcom infringed claims 20
 13 and 22 of the ‘710 Patent, claims 11 and 18 of the ‘032 Patent, and claim 13 of the ‘781 Patent,
 14 and awarded Caltech over \$1.1 billion in damages. C.D. Cal. Dkt. 2114 (Jury Verdict). In
 15 accordance with Caltech withdrawing the ‘833 Patent and various claims of the ‘781, ‘710, and
 16 ‘032 Patents, the judgment entered by the Central District of California does not reflect any
 17 disposition with respect to that patent or those claims. C.D. Cal. Dkt. 2245.

18 Apple and Broadcom appealed to the Federal Circuit, which, in February 2022, (1) upheld
 19 the jury’s verdict of infringement of the ‘710 and ‘032 Patent claims, (2) vacated the jury’s verdict
 20 of infringement of the ‘781 Patent claim, (3) vacated the damages award, and (4) remanded for a
 21 new trial on infringement of the ‘781 Patent claim and damages. *California Inst. of Tech. v.*
 22 *Broadcom Ltd.*, 25 F.4th 976, 980 (Fed. Cir. 2022), *petition for cert. filed* Sept. 7, 2022. In short,
 23 after the Federal Circuit’s decision, there is no final judgment on remedy in the C.D. Cal. Action,
 24 and there is no final judgment on liability with respect to the ‘781 Patent. And the new trial will
 25 not happen until June 2023. *See* C.D. Cal. Dkt. 2453 (order setting a June 6, 2023 trial date).
 26
 27

1 In the C.D. Cal. Action, Caltech is not asserting any claims or seeking damages based on
 2 Broadcom's sales of chips to Samsung for use in the accused Samsung products, as Broadcom
 3 itself has acknowledged. Ex. 5 at 4 (Broadcom acknowledging "Caltech's decision in the prior
 4 case to drop its claims against Samsung products containing Broadcom chips"); Ex. 6 at 6 ("Q. . .
 5 . [A]part from these numbers were there additional WiFi chips with LDPC codes that Broadcom
 6 sold during the relevant time period here that are not included in these numbers? A. Yes. There's
 7 other WiFi chips that Broadcom sold to other end customers, not Apple end customers, like
 8 Samsung [N]one of that's in here. That's not part of this case, but those are chips Broadcom
 9 sold.") (Jan. 22, 2020 C.D. Cal. trial testimony from Caltech's damages expert team).

10 C. The E.D. Tex. Action against Samsung

11 The E.D. Tex. Action is a suit brought by Caltech against Samsung Electronics Co., Ltd.
 12 and Samsung Electronics America, Inc. ("Samsung") for infringement of the Asserted Patents.
 13 Caltech filed that action in December 2021, alleging that certain Wi-Fi products sold by Samsung
 14 infringe the Asserted Patents.

15 Specifically, Caltech is accusing all Samsung products that are Wi-Fi enabled and comply
 16 with any of the IEEE 802.11n, 802.11ac, or 802.11ax standards. Caltech served a pair of
 17 interrogatories asking Samsung to identify all of its Wi-Fi-enabled products and, for each such
 18 product, to identify the chip that is used as part of the Wi-Fi functionality. Bhalla Dec. ¶ 2. In its
 19 initial and supplemental interrogatory responses, Samsung identified dozens of products that use
 20 20 different Wi-Fi chips manufactured by Broadcom. *Id.* ¶ 3. Samsung did not assert any
 21 objections or resist identifying any Broadcom chips on the basis of the C.D. Cal. Action. *Id.* ¶ 4.
 22 And, in fact, in later produced sales data, Samsung included information about the sales of
 23 Samsung products that use the same Broadcom chips that are at issue in the C.D. Cal. Action. *Id.*

24 Because the Wi-Fi chip in each Samsung product performs a relevant functionality, Caltech
 25 has pursued discovery from each of the chipmakers identified by Samsung, including Broadcom.
 26 Of all the chipmakers, only Broadcom has resisted producing responsive materials. *Id.* ¶ 15.

D. The Broadcom Subpoenas

In April 2022, Caltech issued two, identical third-party subpoenas to Broadcom Corp. and its parent entity, Broadcom Inc. *See* Exs. 1, 2. The subpoenas seek documents and source code pertaining to chips that Broadcom supplies to Samsung, identified by Samsung as relevant to the accused Samsung products.

The subpoenas seek the following relevant information about Broadcom's Wi-Fi chips:

- Request Nos. 1 and 2: Technical documents and source code showing how the Broadcom Wi-Fi chips perform LDPC encoding and decoding and the inputs and outputs of the LDPC encoder/decoders.
- Request No. 3: Data sheets for the Broadcom Wi-Fi chips.
- Request No. 4: Documents showing any third-party technology used by the Broadcom Wi-Fi chips.
- Request No. 5: Documents showing the compliance with the IEEE 802.11n, 802.11ac, and 802.11ax standards by the Broadcom Wi-Fi chips.
- Request No. 6: Documents provided to Broadcom by its customers pertaining to various performance metrics of the Wi-Fi chips.
- Request No. 7: Documents relating to the testing of the LDPC functionality in the Wi-Fi chips that Broadcom sold to Samsung.
- Request No. 8: Documents showing the amount and price for which Broadcom sold Wi-Fi chips to Samsung.
- Request No. 9: Communications or agreements between Broadcom and Samsung pertaining to Caltech, the Asserted Patents, or the E.D. Tex. Action.
- Request No. 10: Documents Broadcom produced in the C.D. Cal. Action.

Id.

To the extent the materials sought by the subpoenas overlap with materials that Broadcom previously provided to Caltech in the C.D. Cal. Action, Caltech is not permitted under the C.D. Cal. Action's protective order to use those materials for any purpose other than the prosecution of

the C.D. Cal. Action. *See* C.D. Cal. Dkt. 101 at 1 (“Protected Material designated under the terms of this Protective Order shall be used by a Receiving Party solely for this case, and shall not be used directly or indirectly for any other purpose whatsoever.”).

Broadcom served its responses to the subpoenas in May 2022, asserting a variety of objections. *See* Exs. 3, 4. The parties met and conferred over a number of months—via telephonic conferences on June 8 and August 8 and via e-mail correspondence—to address those objections. Bhalla Dec. ¶ 7; Ex. 5 (meet-and-confer correspondence). The focus of those discussions was one of Broadcom’s global objections, which it stated as follows and incorporated into each of its individual objections:

Broadcom objects to Caltech’s subpoena seeking documents related to *The California Institute of Technology v. Broadcom Ltd., et al.*, C.D. Cal Case No. 2:16-cv-03714-GW-AGRx (“*Broadcom* case”) litigation for use in this matter. In the *Samsung* case, Caltech appears to accuse Samsung products that include the same Broadcom chips as were at issue in the *Broadcom* case and of infringing the same patents (or patents with materially similar claims) as those asserted and litigated to final judgment in the *Broadcom* case. As such, Caltech’s claims against Samsung are barred by the doctrine of claim preclusion, and thus the discovery sought by the subpoena is irrelevant, unduly burdensome, and not proportional to the needs of the case.

Ex. 3 at 3; Ex. 4 at 3.

Broadcom presented claim preclusion as a universal, gating issue to the entirety of Caltech’s requests. *Id.*; Bhalla Dec. ¶ 8. In Broadcom’s view, it was not obligated to produce any discovery in response to the subpoenas beyond documents sufficient to show the chips and patents at issue in the C.D. Cal. Action. Bhalla Dec. ¶ 11; Ex. 5 at 4.¹ Anything beyond that, Broadcom maintained, would not be proportional to the needs of the case.

After Caltech provided caselaw definitively establishing that there could be no claim preclusion based on the C.D. Cal. Action—because “a final judgment on liability without a final

¹ Of the 20 Broadcom chips at issue, Broadcom asserts that 18 of them are involved in the C.D. Cal. Action and discovery into those chips in the E.D. Tex. Action is barred by claim preclusion. Bhalla Dec. ¶¶ 11, 13. It asserts that discovery into the 19th chip is similarly barred because, even though it is *not involved in the C.D. Cal. Action*, it was “sold as early as 2018” and Caltech “could have” accused it in the C.D. Cal. Action. *Id.* ¶ 11. And Broadcom offered to produce a document, but not source code, showing that the 20th chip uses a direct parity encoder, which Broadcom asserts is non-infringing. *Id.*

judgment on remedy is not sufficiently final for purposes of claim preclusion,” Ex. 5 at 5—
 Broadcom switched gears from arguing claim *preclusion* to arguing claim *splitting*. *Id.* at 4
 (“Caltech’s claims against Samsung are barred by the doctrine of claim preclusion and, in
 particular, the prohibition against claim-splitting.”). At that point, the parties reached an impasse.

III. Legal Standard

The scope of permissible discovery under Rule 26 of the Federal Rules of Civil Procedure
 is “broad.” *Republic of Ecuador v. Mackay*, 742 F.3d 860, 866 (9th Cir. 2014) (citation omitted).
 “Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s
 claim or defense and proportional to the needs of the case.” Fed. R. Civ. P. 26(b)(1). A
 determination of proportionality is made “considering the importance of the issues at stake in the
 action, the amount in controversy, the parties’ relative access to relevant information, the parties’
 resources, the importance of the discovery in resolving the issues, and whether the burden or
 expense of the proposed discovery outweighs its likely benefit.” *Id.*

Under Rule 45, a party may seek discovery from non-parties, and the permissible scope of
 that discovery is the same as the permissible scope under Rule 26. *See In re Samsung Elecs. Co.*,
 No. 22-MC-80005-VKD, 2022 WL 425579, at *1 (N.D. Cal. Feb. 11, 2022); *Gonzales v. Google*,
Inc., 234 F.R.D. 674, 680 (N.D. Cal. 2006).

On a motion to compel discovery, “[o]nce the moving party establishes that the information
 requested is within the scope of permissible discovery, the burden shifts to the party opposing
 discovery” to establish why the discovery should not be permitted. *Khalilpour v. CELLCO P’ship*,
 No. C 09-02712 CW MEJ, 2010 WL 1267749, at *1 (N.D. Cal. Apr. 1, 2010); *SanDisk Corp. v.*
Round Rock Rsch. LLC, No. 11-CV-05243-RS, 2014 WL 691565, at *1 (N.D. Cal. Feb. 21, 2014).

IV. Argument

A. The discovery sought from Broadcom is relevant.

The Asserted Patents disclose error correction codes, including LDPC codes, and the
 claimed methods and apparatuses in the Asserted Patents are directed to correct errors in

transmissions that occur over a wireless communications channel, such as a Wi-Fi channel. Samsung has identified dozens of “Wi-Fi products with LDPC functionality” that include 20 different chips manufactured by Broadcom. Bhalla Dec. ¶ 3. Because Caltech’s infringement allegations focus on LDPC functionality and Samsung has identified specific Samsung products that use Broadcom chips to provide LDPC functionality, the requested materials are relevant. Broadcom has not contested the relevance of LDPC functionality to the Asserted Patents in its written objections or during the meet and confer process.

Specifically, Request Nos. 1-7 pertain to the technical operation of the chips. Understanding the operation of the chips is directly relevant to the claim that Samsung products infringe the Asserted Patents, and the most direct evidence of how those chips operate is encompassed by these requests. Request Nos. 6-8 are relevant to Caltech’s damages. Documents responsive to these requests bear on the value of the functionality provided by the Broadcom chips. Request No. 9 seeks Broadcom’s communications or agreements with Samsung pertaining to Caltech, the Asserted Patents, and the E.D. Tex. Action—materials that will include any indemnification agreements between Samsung and Broadcom and communications about plainly relevant topics, such as the Asserted Patents. Finally, Request No. 10 simply seeks the materials that Broadcom produced in the C.D. Cal. Action, which will necessarily encompass relevant materials pertaining to the 18 chips that Broadcom claims are involved in both the E.D. Tex. and C.D. Cal. Actions.

B. The discovery sought from Broadcom is proportional.

The Rule 26(b)(1) proportionality factors all weigh in favor of Caltech.

First, “the issues at stake in the action” and the “importance of the discovery in resolving th[ose] issues” are significant. Fed. R. Civ. P. 26(b)(1). The central issue of the E.D. Tex. litigation is whether the accused Samsung products infringe the Asserted Patents. Fundamental intellectual property rights are thus at stake and the discovery sought from Broadcom is integral to understanding the relevant Wi-Fi functionality of the accused Samsung products.

1 Second, the amount in controversy is significant, as evidenced by the \$1.1 billion awarded
2 by the jury in the C.D. Cal. Action and the fact that Samsung, like Apple (against which the jury
3 assessed \$838 million in damages in the C.D. Cal. Action, *see* C.D. Cal. Dkt. 2114), is a large and
4 substantial manufacturer of Wi-Fi-enabled consumer electronics, *see* Samsung,
5 <https://www.samsung.com/us/> (listing for sale dozens of Wi-Fi enabled products across multiple
6 product categories); *Samsung Electronics Announces Third Quarter 2022 Results* (Oct. 27, 2022),
7 <https://news.samsung.com/global/samsung-electronics-announces-third-quarter-2022-results>
8 (reporting \$7.9 billion in operating profit).

9 Third, as between Caltech and Broadcom, Broadcom has the best access to relevant
10 information regarding its own chips and how they work. In fact, much of the information sought
11 from Broadcom cannot be obtained anywhere else. For example, Broadcom is the sole steward of
12 its source code, and Caltech is not permitted to use the discovery it received from Broadcom in the
13 C.D. Cal. Action outside of that litigation. And as a large and profitable corporation, Broadcom
14 certainly has the resources to provide the requested discovery. *See Broadcom Inc. Announces Third*
15 *Quarter Fiscal Year 2022 Financial Results and Quarterly Dividends*, Broadcom (Sep. 1, 2022),
16 <https://www.broadcom.com/company/news/financial-releases/60481> (reporting net income of
17 \$3.1 billion).

18 Finally, the burden or expense of the proposed discovery does not outweigh its likely
19 benefit, especially given the importance of the proposed discovery to understanding the relevant
20 operations of the accused Samsung products and that much of the source code and related technical
21 documents have *already been* collected and produced by Broadcom in the C.D. Cal. Action. In
22 light of this, there is no colorable burden defense that Broadcom can maintain.

23 For all these reasons, the discovery sought from Broadcom is proportional to its relevance.
24 Nevertheless, Broadcom challenges the discovery at issue on the basis of claim preclusion and
25 claim splitting. Neither position has merit.

1 **C. Broadcom is not entitled to assert a claim preclusion defense.**

2 Broadcom has no basis to assert a claim preclusion defense because it is not a party to the
 3 E.D. Tex. Action. “Claim preclusion, like issue preclusion, is an *affirmative defense*. . . .
 4 Ordinarily, it is incumbent on the *defendant* to plead and prove such a defense” *Taylor v.*
 5 *Sturgell*, 553 U.S. 880, 907 (2008) (citations omitted) (emphasis added). Consistent with this,
 6 discussions of the defense refer to it being asserted by a *party*. *See, e.g.*, 18 Charles Alan Wright
 7 & Arthur R. Miller, *Federal Practice and Procedure* § 4405 (3d ed.) (“Once properly raised, a
 8 *party* asserting preclusion must carry the burden of establishing all necessary elements.” (emphasis
 9 added)); Fed. R. Civ. P. 8(c) (requiring that “a *party* must affirmatively state” the affirmative
 10 defense of res judicata (emphasis added)).

11 Here, Broadcom is attempting to assert a claim preclusion defense on *behalf of a party*,
 12 Samsung, to resist discovery that Samsung itself is not even resisting. In other words, though not
 13 facing suit, Broadcom is attempting to assert a defense that is only available to a litigant. Applying
 14 claim preclusion here would take it outside the context in which it’s meant to be applied. As one
 15 court explained, “[t]he doctrine of res judicata is meant to protect parties against being harassed
 16 by repetitive actions.” *Bell v. United States*, No. CV F 02–5077, 2002 WL 1987395, at *4 (E.D.
 17 Cal. 2002). But non-party Broadcom is not facing “repetitive actions.”

18 Similarly, claim preclusion most often arises when a party who **lost** an initial suit seeks a
 19 second bite at the apple through a second suit. *Rogers v. Rivera*, No. 115CV00007MCASCY, 2017
 20 WL 3405606, at *4 (D.N.M. Mar. 28, 2017) (“Claim preclusion is sometimes described as a tool
 21 used to prevent a party from having ‘two bites at the apple.’” (citation omitted)). Caltech is not
 22 seeking a second bite at the apple, nor is it seeking to relitigate issues that it lost in a previous suit.
 23 It is seeking to enforce patents—including claims and patents that it successfully enforced in the
 24 C.D. Cal. Action and claims and patents not at issue in the C.D. Cal. Action—against Samsung
 25 products that use Broadcom chips. The chips that Broadcom sold to Samsung were explicitly
 26
 27

1 excluded from the C.D. Cal. Action, and two new Broadcom chips, not involved in the C.D. Cal.
2 Action, are at issue in the E.D. Tex. Action.

3 And in patent cases, claim preclusion presents factual issues for the jury to resolve. So, at
4 best, Broadcom’s argument is one that *Samsung* might be able to make *to the jury*. *Oyster Optics,*
5 *LLC v. Cisco Sys., Inc.*, No. 2:20-CV-00211-JRG, 2021 WL 1530935, at *4 (E.D. Tex. Apr. 16,
6 2021) (“Once the Court has construed the claims, Cisco may present evidence *to the jury*—*e.g.*,
7 evidence that the claims are patentably indistinct from others—to prove its assertion that the claims
8 are essentially the same as other claims previously litigated.” (emphasis added)). But it is not an
9 argument that Broadcom can assert to resist plainly relevant discovery at this early stage.

10 All these principles caution against the novel application of claim preclusion that
11 Broadcom seeks here. “Preclusion is designed to limit a plaintiff to one bite at the apple, not to
12 prevent even that single bite.” *Hurd v. D.C.*, 864 F.3d 671, 679 (D.C. Cir. 2017). Caltech is now
13 taking that single bite against Samsung.

14 Nevertheless, even if Broadcom were entitled to assert a claim preclusion defense, it could
15 not satisfy the elements of that defense.

16 **D. There is no claim preclusion.**

17 “Under the doctrine of claim preclusion, ‘[a] final judgment on the merits of an action
18 precludes the parties or their privies from relitigating issues that were or could have been raised in
19 that action.’” *Rivet v. Regions Bank of Louisiana*, 522 U.S. 470, 476 (1998) (quoting *Federated*
20 *Department Stores, Inc. v. Moitie*, 452 U.S. 394, 398 (1981)). A court can apply claim preclusion
21 only when the prior suit: “(1) involved the same claim or cause of action as the later suit; (2)
22 reached a final judgment on the merits; and (3) involved the same parties or privies.” *Brain Life,*
23 *LLC v. Elekta Inc.*, 746 F.3d 1045, 1052 (Fed. Cir. 2014) (applying Ninth Circuit law from *Mpoyo*
24 *v. Litton Electro–Optical Sys.*, 430 F.3d 985, 987 (9th Cir. 2005)). Broadcom cannot satisfy *any*
25 of these prongs.

1 **1. The two Actions do not involve the same claim or cause of action.**

2 The C.D. Cal. Action does not involve the same claim or cause of action as the E.D. Tex.
3 Action because different products and an additional patent/patent claims are at issue. The issue of
4 whether “two claims of infringement constitute the same claim or cause of action is an issue
5 particular to patent law” that is subject to Federal Circuit precedent. *Id.* at 1052. The Federal
6 Circuit “define[s] a cause of action based on the transactional facts from which it arises,” and “[i]n
7 a patent case, transactional facts include ‘both the asserted patents and the accused activity.’” *XY, LLC v. Trans Ova Genetics, LC*, 968 F.3d 1323, 1333 (Fed. Cir. 2020) (citations omitted).

9 The C.D. Cal. and E.D. Tex. Actions do not involve the same accused products. An
10 “‘infringement claim,’ for purposes of claim preclusion [does not] embrace [] more than the
11 specific *devices* before the court in the first suit.” *Brain Life*, 746 F.3d at 1053 (quoting *Young*
12 *Eng’rs Inc. v. U.S. Int’l Trade Comm’n*, 721 F.2d 1305, 1316 (Fed.Cir.1983)) (emphasis added);
13 *see Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 479 (Fed. Cir. 1991) (“An essential fact of a patent
14 infringement claim is the structure of the device or devices in issue.”). And “[a]djudication of
15 liability for infringement is a determination that *a thing* is made, used or sold without authority
16 under the claim(s) of a valid enforceable patent.” *Brain Life*, 746 F.3d at 1053 1053 (quoting *Young*
17 *Eng’rs*, 721 F.2d at 1316) (emphasis added).

18 The “devices” and “thing[s]” before the Court in the C.D. Cal. Action are not the same as
19 the devices and things before the Court in the E.D. Tex. Action. The C.D. Cal. Action involves
20 *Apple* and *Broadcom* products, while the E.D. Tex. Action involves *Samsung* products. *Compare*
21 First Amended Complaint ¶ 36, C.D. Cal. Dkt. 36 (accusing “Broadcom products that incorporate
22 IRA/LDPC encoders and/or decoders”); *id.* ¶ (accusing “Apple products that incorporate
23 IRA/LDPC encoders and/or decoders”) *with* Second Amended Complaint ¶ 37, E.D. Tex. Dkt. 75
24 (accusing Samsung “Wi-Fi products that incorporate encoders and/or decoders claimed in the
25 Asserted Patents”).
26
27

1 It is inapposite that some of the accused Samsung products use Broadcom chips that were
 2 initially accused in the C.D. Cal. Action or that some of the accused Samsung products use
 3 Broadcom chips that are also used by Apple products accused in the C.D. Cal. Action. Such overlap
 4 does not transform a Samsung product that uses a Broadcom chip into the same *thing* as a
 5 Broadcom chip. Nor does it make a Samsung product that uses a Broadcom chip the same thing
 6 as an Apple product that uses that Broadcom chip. Regardless of any intersection, Broadcom chips,
 7 Apple products, and Samsung products remain distinct and separate “thing[s].”

8 Moreover, Caltech explicitly *excluded* Broadcom’s sales to Samsung for use in its devices
 9 from the damages it is seeking in the C.D. Cal. Action. Ex. 6 at 5 (“The hypothetical negotiation
 10 that we’re talking about is only as it pertains to Apple and Broadcom and the Apple related
 11 infringement and Broadcom’s infringement related to Apple and these imports into the U.S. That’s
 12 it. Those are all we looked at. Those are the only chips at issue in this case.”). That is, Caltech did
 13 not accuse the Broadcom chips to the extent those chips were sold to Samsung for use in the
 14 devices that Caltech is accusing in the E.D. Tex. Action. Broadcom acknowledged this during the
 15 meet and confer process. Ex. 5 at 4 (acknowledging “Caltech’s decision in the prior case to drop
 16 its claims against Samsung products containing Broadcom chips”). As a result, the purported
 17 “overlap” is, in reality, no overlap at all because Caltech did not pursue claims based on Broadcom
 18 chips sold to Samsung for use in the accused Samsung products.

19 Further widening the gap between the products at issue in the two Actions, there are two
 20 Broadcom chips used in the accused Samsung products that are *not at issue* in the C.D. Cal. Action.
 21 For the first chip, Broadcom asserts that because it was “sold as early as 2018,” Caltech is still
 22 precluded because it “could have” accused it in the C.D. Cal. Action. Bhalla Dec. ¶ 11. The law is
 23 clear that “the products at issue in a patent suit are those in existence at the time the suit is filed.”
 24 *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1346 (Fed. Cir. 2012). The C.D.
 25 Cal. Action was filed in 2016, and the chip at issue was not sold until 2018. The fact that Caltech
 26 did not seek to amend the C.D. Cal. Action to include this chip cannot be the basis for any form of
 27

preclusion. *See MLC Intell. Prop., LLC v. Micron Tech., Inc.*, No. 19-CV-03345, 2019 WL 4963253, at *4 (N.D. Cal. Oct. 8, 2019) (“While a party may seek to pursue claims that accrue during the pendency of a lawsuit, the party is not required to do so, and res judicata will not be applied to such accruing claims if the party elects not to have them included in the action.”).

For the second chip, Broadcom asserts that it is non-infringing. But Broadcom’s assertion does not relieve Broadcom of its discovery obligations, and it should still produce responsive material pertaining to that chip. Despite Broadcom’s claim that the chip employs a non-infringing encoder, and its apparent willingness to produce a document showing the type of encoder it employs, Samsung has identified it as providing LDPC functionality for an accused product, establishing its relevance. Caltech should be permitted to assess the operation of the chip for itself, and in order to do that, Caltech needs the discovery sought by the subpoena.

The C.D. Cal. and E.D. Tex. Actions also do not involve all of the same patents. In addition to there being separate products at issue in the two Actions, there are additional patents and patent claims at issue. In the E.D. Tex. Action, Caltech is asserting the ‘833 Patent. Though Caltech initially asserted the ‘833 Patent in the C.D. Cal. Action, it voluntarily withdrew it, as discussed above, *two years* before trial. Further, Caltech is asserting numerous claims of the ‘710, ‘732, and ‘032 Patents that were voluntarily withdrawn in the C.D. Cal. Action.²

Caselaw clearly establishes that a voluntary withdrawal of a patent or particular claims carries no preclusive effect, even with respect to the party against which those claims were initially asserted. A “‘patentee’s voluntary withdraw[al] of previously asserted patent claims’ for the purpose of narrowing a case is treated as a dismissal without prejudice.” *Oyster Optics*, 2021 WL 1530935, at *5 (E.D. Tex. Apr. 16, 2021) (citation omitted); *SanDisk Corp. v. Kingston Tech. Co.*,

² As explained earlier, Caltech voluntarily withdrew all but the following claims in the C.D. Cal. Action: claims 20 and 22 of the ‘710 Patent, claims 11 and 18 of the ‘032 Patent, and claims 13 and 22 of the ‘781 Patent. In the E.D. Tex. Action, Caltech is presently asserting the following, larger set of claims: claims 11-17 and 19-33 of the ‘710 Patent, claims 1-8 and 10-22 of the ‘032 Patent, claims 3-18 and 22 of the ‘781 Patent, and claims 1-4, 6-11, and 13-14 of the ‘833 Patent. Bhalla Dec. ¶ 16.

1 695 F.3d 1348, 1353 (Fed. Cir. 2012) (noting that the voluntarily withdrawal of claims is “akin to
2 either a Federal Rule of Civil Procedure 15 amendment to the complaint . . . or a Rule 41(a)
3 voluntary dismissal of claims without prejudice” (citation omitted)). And a dismissal without
4 prejudice “should not preclude re-litigation of the dismissed claims in the same court.” *Oyster*
5 *Optics*, 2021 WL 1530935, at *5. Such a dismissal does not even prevent “the plaintiff from
6 returning later, to the same court, with the same underlying claim.” *Semtek Int’l Inc. v. Lockheed*
7 *Martin Corp.*, 531 U.S. 497, 505 (2001).

8 If Caltech would be permitted to again sue Broadcom directly on the patent and claims it
9 voluntarily withdrew, it follows that Caltech is certainly permitted to sue a *different party* on that
10 very patent and those very claims. But that is precisely what Broadcom argues Caltech *cannot* do.
11 The Court should reject this baseless argument.

12 As indicated in Broadcom’s subpoena objections, Caltech expects Broadcom to argue that
13 Caltech is precluded from asserting the ‘833 Patent and the withdrawn claims because they are
14 “essentially the same” as the claims that Caltech is asserting in the C.D. Cal. Action. *See SimpleAir,*
15 *Inc. v. Google LLC*, 884 F.3d 1160, 1167 (Fed. Cir. 2018) (“[W]here different patents are asserted
16 in a first and second suit, a judgment in the first suit will trigger claim preclusion only if the scope
17 of the asserted patent claims in the two suits is essentially the same.”).

18 That question, however, is for the jury (assuming it’s actually raised by the actual party in
19 suit with Caltech). As such, it cannot be resolved at this stage and thus cannot be used as a basis
20 to refuse discovery. “The comparison of different claims in different patents for the purpose of
21 determining whether they are ‘essentially the same’ is a question of fact, not a question of law”
22 and is “for the jury to decide.” *Oyster Optics*, 2021 WL 1530935, at *3. It is the burden of the
23 party asserting claim preclusion to show “that the asserted patent claims in the two suits are
24 essentially the same,” *id.* at *4, and Broadcom cannot meet that burden where, as here, claim
25 construction has not even occurred in the E.D. Tex. Action. Without claim construction, the scope
26 of the asserted claims remains in flux, and until that scope is finalized, the asserted claims cannot
27

1 be compared across the two Actions. *Id.* (“Once the Court has construed the claims, Cisco may
 2 present evidence to the jury—e.g., evidence that the claims are patentably indistinct from others—
 3 to prove its assertion that the claims are essentially the same as other claims previously litigated.”
 4 (emphasis added)).

5 **2. There has been no final judgment.**

6 Next, there has been no final judgment in the C.D. Cal. Action. While Caltech has already
 7 *won* an infringement verdict on the ‘710 and ‘032 Patents in the C.D. Cal. Action, the issue of
 8 infringement of the ‘781 Patent has not been finalized, nor have damages been awarded on remand.
 9 It is blackletter law that a final judgment on liability without a final judgment on remedy is not
 10 sufficiently final for purposes of claim preclusion. *See Fresenius USA, Inc. v. Baxter Int’l, Inc.*,
 11 721 F.3d 1330, 1341 (Fed. Cir. 2013) (“Looking to general res judicata principles governing the
 12 preclusive effect of a judgment, it is well-established that where the scope of relief remains to be
 13 determined, there is no final judgment binding the parties (or the court).”); *Mendenhall v. Barber-*
 14 *Greene Co.*, 26 F.3d 1573, 1580 (Fed. Cir. 1994) (“Secondly, the judgment of this court on liability
 15 in Astec resulted in a remand for further proceedings. It was not the final judgment in the case. To
 16 rise to that level, the litigation must be entirely concluded so that Mendenhall’s cause of action
 17 against Astec was merged into a final judgment.” (citing Restatement (Second) of Judgments § 13
 18 (1982))). As such, *none* of the Asserted Patents in the E.D. Tex. Action is yet subject to a final
 19 judgment.³

20 **3. The two Actions do not involve the same parties or privies.**

21 Finally, there is no claim preclusion because the C.D. Cal. Action and the E.D. Tex. Action
 22 do not involve the same parties. The C.D. Cal. Action involves Apple and Broadcom whereas the
 23 E.D. Tex. Action involves Samsung. Nor is Samsung a privy of Apple or Broadcom. On this point,
 24

25 ³ There is no final judgment for the ‘710 or ‘032 Patents because the remedy for the infringement
 26 of those patents has not yet been determined. There’s no final judgment for the ‘781 Patent because
 27 the Federal Circuit vacated the liability and damages judgment for that patent. And there’s no final
 judgment for the ‘833 Patent because, as discussed, it was withdrawn from the C.D. Cal. Action.

1 the only evidence Broadcom has offered to support such a finding is that “Broadcom had the same
2 interest to defend against [Caltech’s] allegations as Samsung does now.” Ex. 5 at 4. But that is
3 insufficient to support the very strict effects of claim preclusion.

4 “Even when the parties are not identical, privity may exist if there is substantial identity
5 between parties, that is, when there is sufficient commonality of interest.” *Tahoe-Sierra Pres.*
6 *Council, Inc. v. Tahoe Reg’l Plan. Agency*, 322 F.3d 1064, 1081 (9th Cir. 2003) (internal quotation
7 marks and citation omitted). “[P]rivacy is a flexible concept dependent on the particular relationship
8 between the parties in each individual set of cases.” *Id.*

9 In *In re Schimmels*, 127 F.3d 875, 881 (9th Cir. 1997), the Ninth Circuit provided the
10 following examples of relationships sufficiently close to establish privity:

11 First, a non-party who has succeeded to a party’s interest in property is bound by any prior
12 judgment against the party. Second, a non-party who controlled the original suit will be
13 bound by the resulting judgment. Third, federal courts will bind a non-party whose interests
14 were represented adequately by a party in the original suit. . . . In addition, ‘privity’ has
15 been found where there is a ‘substantial identity’ between the party and nonparty . . . ;
16 where the nonparty ‘had a significant interest and participated in the prior action,’ . . . ; and
17 where the interests of the nonparty and party are ‘so closely aligned as to be virtually
18 representative,’ Finally, a relationship of privity can be said to exist when there is an
19 ‘express or implied legal relationship by which parties to the first suit are accountable to
20 non-parties who file a subsequent suit with identical issues.’

21 *Id.* (citations and internal quotation marks omitted). None of the relationships enumerated in *In re*
22 *Schimmels* describe the relationship between Broadcom and Samsung. Broadcom’s bare assertion
23 that it and Samsung have the “same interest to defend against” falls far short of establishing any
24 of the above relationships. And the only apparent alignment in interest between Broadcom and
25 Samsung is the general interest any defendant has in avoiding a finding of liability or an award of
26 damages. Nor is **Broadcom** in a position to say whether **Samsung’s** interests are adequately
27 represented in the C.D. Cal. Action. If anything, the different litigation strategies that Samsung is
pursuing in the E.D. Tex. Action indicate that they are not.

1 By all indications, the Samsung-Broadcom relationship is an arms-length commercial one
 2 in which Samsung purchases a product from Broadcom that it then installs and configures within
 3 a separate product that it sells. That is not sufficient to establish privity.

4 * * *

5 There are thus four, independent reasons why claim preclusion does not apply to the E.D.
 6 Tex. Action. Across the two Actions: (1) the accused products are different, (2) the asserted patents
 7 and claims are different, (3) there has been no final judgment, and (4) the parties are different and
 8 the relevant parties are not in privity.

9 **E. There is no claim splitting.**

10 Broadcom has also maintained that, if claim preclusion does not apply, then claim splitting
 11 prevents Caltech from obtaining the discovery at issue. This argument is likewise without merit.

12 The doctrine of claim splitting derives from the concept that a plaintiff generally lacks a
 13 “right to maintain two separate actions involving the same subject matter at the same time in the
 14 same court and against the same defendant.” *Adams v. California Dep’t of Health Servs.*, 487 F.3d
 15 684, 688 (9th Cir. 2007) (citation omitted). The claim-splitting analysis is closely related to the
 16 claim preclusion analysis. “[I]n the claim-splitting context, the appropriate inquiry is whether,
 17 assuming that the first suit were already final, the second suit could be precluded pursuant to claim
 18 preclusion.” *Hartsel Springs Ranch of Colorado, Inc. v. Bluegreen Corp.*, 296 F.3d 982, 987 n.1
 19 (10th Cir. 2002); *see Adams*, 487 F.3d at 688 (same).

20 For all the reasons already discussed, even if the C.D. Cal. Action were deemed final, it
 21 would have no effect on Broadcom’s discovery obligations because there are different patent
 22 claims, products, defendants, and causes of action at issue across the two Actions. And to the extent
 23 claim splitting can be extended to privies, *see Adams*, 487 F.3d at 688, for the reasons discussed
 24 above, such extension is inappropriate here, where Broadcom and Samsung are not privies. Just as
 25 there is no basis for claim preclusion, there is no basis for claim splitting.

1 **V. Conclusion**

2 For the foregoing reasons, this Court should compel Broadcom's compliance with the
3 subpoenas and enter the attached proposed order.

4
5 DATED: November 21, 2022

6 Respectfully submitted,

7 By: /s/ Kalpana Srinivasan

8 Kalpana Srinivasan
9 California State Bar No. 237460
10 ksrinivasan@susmangodfrey.com
11 **SUSMAN GODFREY LLP**
12 1900 Avenue of the Stars, Suite 1400
13 Los Angeles, CA 90067
14 Telephone: (310) 789-3100
15 Facsimile: (310) 789-3150

16 Ravi Bhalla
17 *Pro hac vice forthcoming*
18 New York State Bar No. 5478223
19 rbhalla@susmangodfrey.com
20 **SUSMAN GODFREY LLP**
21 1301 Avenue of the Americas, 32nd Fl.
22 New York, NY 10019
23 Telephone: (212) 336-8330
24 Facsimile: (212) 336-8340

25 *Attorneys for Plaintiff California Institute of*
26 *Technology*
27

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been served via e-mail on the following individual, counsel for Broadcom, who represented to me via e-mail that he is authorized to accept electronic service of this notice and motion on behalf of Broadcom Corp. and Broadcom Inc. *See* Ex. 5 at 2.

Taylor Gooch
WilmerHale
One Front Street, Suite 3500
San Francisco, CA 94111 USA
Taylor.Gooch@wilmerhale.com

/s/ Ravi Bhalla

Ravi Bhalla